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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,173	10/23/2003	Yen-Fu Chen	AUS920030664US1	8343

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IBM CORPORATION (RHF)
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EXAMINER

SHIH, HAOSHIAN

ART UNIT	PAPER NUMBER
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2173

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/692,173

Applicant(s)

CHEN ET AL.

Examiner

Haoshian Shih

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/23/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/23/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-15 are pending in this application and have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 4 recites the limitation "said steps of..." in lines 1. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 11-15 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.**

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7. Regarding claims 11-15, although the preamble of the claims recite "system", the body of the claims include only software components such as "transfer interceptor", "compatibility checker", "compatibility action handler", "rule management user interface". Claims 11-15 neither include any computer hardware component(s) nor positively recite that the cited software components are stored on a computer medium that can be read by a machine. As such, claims 11-15 are directed to software per se which is non-functional descriptive material and non-statutory since the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1, 5-6, 10-11 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Stern et al. (Stern, US 6,807,668 B2).**

10. As to **independent** claim 1, Stern discloses a method for transferring content from one computer resource to another computer resource (col.8, lines 31-35; content is

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transferred (drag) from source to destination (drop)), comprising the steps of: intercepting the transfer to a destination of one or more information elements selected from a source (col.10, lines 36-43; contents are stored in a intermediate storage for further processing) performing a compatibility check for each intercepted information element with the destination (col.9, lines 35-44; source data are checked to ensure the destination can accept it) by consulting one or more user-configurable compatibility rules to classify elements as incompatible or compatible (col.45, lines 6-9, lines 31-34; "GetFlavorFlags" determines compatibility, "GetFlavorData" determines data type, user uses the data returned from the functions described above to configure compatibility rules) for each incompatible element, performing a compatibility handling action (see "translation manager", col.9 lines 40-57) as defined by one or more conversion rules; and for each compatible element, allowing transfer of the unmodified compatible element to the destination (col.7, lines 60-64; col.9, lines 36-40).

11. As to **independent** claim 6, Stern discloses a computer readable medium encoded with software (fig.3) for transferring content from one computer resource to another computer resource (col.8, lines 31-35; content is transferred (drag) from source to destination (drop)), comprising the steps of: intercepting the transfer to a destination of one or more information elements selected from a source (col.10, lines 36-43; contents are stored in a intermediate storage for further processing) performing a compatibility check for each intercepted information element with the destination (col.9, lines 35-44; source data are checked to ensure the destination can accept it) by

consulting one or more user-configurable compatibility rules to classify elements as incompatible or compatible (col.45, lines 6-9, lines 31-34; "GetFlavorFlags" determines compatibility, "GetFlavorData" determines data type, user uses the data returned from the functions described above to configure compatibility rules) for each incompatible element, performing a compatibility handling action as defined by one or more conversion rules (see "translation manager", col.9 lines 40-57); and for each compatible element, allowing transfer of the unmodified compatible element to the destination (col.7, lines 60-64; col.9, lines 36-40).

12. As to **independent** claim 11, Stern discloses a system for automatically transferring content from one computer resource to another computer resource, comprising: a transfer interceptor configured to intercept one or more information elements selected from a source prior to insertion into a destination (col.10, lines 36-43; contents are stored in a intermediate storage for further processing); a compatibility checker adapted to verify the compatibility of each intercepted information element with the destination (col.9, lines 35-44; source data are checked to ensure the destination can accept it) by consulting one or more user-configurable compatibility rules to classify elements as incompatible or compatible (col.45, lines 6-9, lines 31-34; "GetFlavorFlags" determines compatibility, "GetFlavorData" determines data type, user uses the data returned from the functions described above to configure compatibility rules); a compatibility action handler configured to performing an action as defined by one or more conversion rules for each intercepted information element (col.9, lines 40-57;

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"translation manager"), and further configured to allowing transfer of said compatible elements to the destination without modification(col.7, lines 60-64; col.9, lines 36-40).

13. As to claims 5, 10 and 15, Stern discloses performing a compatibility handling action comprises performing an action selected from the list of converting a text element from one format to another format, converting a graphic image element from one format to another format, converting a video clip element from one format to another format, converting an audio clip element from one format to another format, converting animated image element from one format to another format (col.65, lines 4-8; each compatible format, (col.7, lines 26-30 defines flavors as different data types, it is consist with the definition of data format) is listed via the translation manager (col.9, lines 49-54)) isolating an element, isolating an element and transferring an annotation to said destination, isolating an element and transferring a hyperlinked annotation to said destination.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-4, 7-9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern, in view of Tomm et al. (Tomm, US 6,560,608 B1), in further view of Tsuji et al. (Tsuji, US 5,586,025).

16. As to claims 2, 7 and 12, Stern does not disclose invoking a rule management user interface responsive to finding no existing compatibility rule for an element to be transferred; allowing, via said rule management user interface, a user action selected from the list of creating a new compatibility rule, deleting a compatibility rule, and modifying a compatibility rule.

In the same field of processing data, Tomm discloses a system for selecting rules to process data. Tomm further teaches invoking a rule management interface ("rule editor") responsive to finding no existing rule for matching for an element to be transferred (fig.6; "630", "640", "650"); Tomm also teaches allowing, via said rule management user interface, a user action to create a new rule (see col.5, lines 35-41).

It would have been obvious to one of ordinary skill in the art, having the teaching of Stern and Tomm before him at the time the invention was made, to modify the system for transferring content taught by Stern to include an interface for adding new rules taught by Tomm with the motivation being to enhance the usefulness of Stern's system

since the added new rules "are available for subsequent [compatibility checking] operations" (see Tomm, col.7, lines 61-62).

Tomm does not disclose deleting a compatibility rule, and modifying a compatibility rule.

In the same field of endeavor, Tsuji discloses a rule management user interface (fig.1, "17"), a user action selected from the list of creating a new rule (col.5, lines 65-66, "registration of a new rule"), deleting a rule (col.6, lines 11-12 "delete the rule base"), and modifying a rule (col.5, lines 67- col.6, lines 2, "changing a stored rule).

It would have been obvious to one of ordinary skill in the art, having the teaching of Stern and Tomm, and the teaching of Tsuji before him at the time the invention was made, to modify system for transferring content taught by Stern *and Tomm* to include the rule deletion and modification taught by Tsuji with the motivation being to provide a customizable user interface for rules manipulation.

17. As to claims 3, 8 and 13, Stern does not disclose invoking a rule management user interface responsive to finding no existing conversion rule for an element to be transferred; and allowing, via said rule management user interface, a user action selected from the list of creating a new conversion rule, deleting a conversion rule, and modifying a conversion rule.

In the same field of processing data, Tomm discloses a system for selecting rules to process data. Tomm further teaches invoking a rule management interface ("rule editor") responsive to finding no existing rule for matching for an element to be transferred (fig.6; "630", "640", "650"); Tomm also teaches allowing, via said rule management user interface, a user action to create a new rule (see col.5, lines 35-41).

It would have been obvious to one of ordinary skill in the art, having the teaching of Stern and Tomm before him at the time the invention was made, to modify the system for transferring content taught by Stern to include an interface for adding new rules taught by Tomm with the motivation being to enhance the usefulness of Stern's system since the added new rules "are available for subsequent [compatibility checking] operations" (see Tomm, col.7, lines 61-62).

Tomm does not disclose deleting a compatibility rule, and modifying a conversion rule.

In the same field of endeavor, Tsuji discloses a rule management user interface (fig.1, "17"), a user action selected from the list of creating a new rule (col.5, lines 65-66, "registration of a new rule"), deleting a rule (col.6, lines 11-12 "delete the rule base"), and modifying a rule (col.5, lines 67- col.6, lines 2, "changing a stored rule").

It would have been obvious to one of ordinary skill in the art, having the teaching of Stern and Tomm, and the teaching of Tsuji before him at the time the invention was

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made, to modify system for transferring content taught by Stern *and Tomm* to include the rule deletion and modification taught by Tsuji with the motivation being to provide a customizable user interface for rules manipulation.

18. As to claims 4, 9 and 14, Stern discloses performing an action selected from the group of converting a text element from one format to another format, converting a graphic image element from one format to another format, converting a video clip element from one format to another format, converting an audio clip element from one format to another format, converting animated image element from one format to another format, (col.65, lines 4-8; each compatible format (col.7, lines 26-30 defines flavors as different data types, it is consist with the definition of data format) is listed via the translation manager (col.9, lines 49-54)) isolating an element, isolating an element and transferring an annotation to said destination, isolating an element and transferring a hyperlinked annotation to said destination.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. Documents that discloses event handler, data transformation and cut & paste that are not sited in the office action are provided in the examiner's reference.

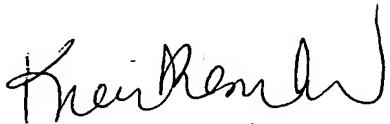
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haoshian Shih whose telephone number is (571) 270-1257. The examiner can normally be reached on m-f 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HSS

A handwritten signature in black ink, appearing to read 'Kieu D. Vu', with a stylized, cursive script.

Kieu D. Vu
Primary Examiner